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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,765	12/28/2000	Mitchell R. Swartz		8044

7590 04/17/2002

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EXAMINER

BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 04/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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The reply filed on 6/18/01 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): The response failed to elect a species from the grouping in section 2 on page 2 of the 6/6/01 Office action.

The election of species requirement in section 5 on page 3 of the 6/6/01 Office action required applicant to elect a single specie of the number of barrier layers and of the material each barrier layer is made of. On the top of page 12 of the 6/18/01 response, applicants election of "at least one barrier layer", is non-responsive because the election is open ended (applicant must elect one of, one layer or, two layers, etc., (and the material for each layer)).

The 6/6/01 Office action had in some instances in defining or reciting the members/species within a particular group, set forth in a parenthetical expression, a reference to a particular portion of the specification or to a claim (e.g. see part A at the bottom of page 2 of the 6/6/01 Office action).

Applicant in several portions of the 6/18/01 response, stated that applicant has examined the location cited by the examiner, does not understand the relevance, and requests clarification (e.g. see the bottom portion of page 7 of the 6/18/01 response).

The relevance is that the specified portion of the specification or specified claim, describes or gives examples of the item in question.

Using part A on the bottom of page 2 of the 6/6/01 Office action as an example, the specification on page 21 gives examples of the embodiment wherein the cathode consists of a single metal only, whereas part C on page 3 of the 6/6/01 Office action refers to the specification

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on page 22 lines 17+ which refers to an embodiment wherein the cathode consists of a composite material (e.g. palladium and epoxy).

It is not clear what applicant means by the statement, "there is no "patentable difference" with respect to the above-entitled application" (e.g. see the top portion of page 8 of the 6/8/01 response).

In this respect, it is noted that if applicant will state on the record that the indicated species within a particular grouping are not patentably distinct, the election of species requirement for that particular grouping will be withdrawn (see the paragraph bridging pages 4 and 5 of the 6/6/01 Office action) (an example of this would be if applicant (in the response to this Office action) would state that the species listed as A-D in section 3 of the 6/6/01 Office action, are obvious variants of one another, then the election of species requirement in said section 3 of the 6/6/01 Office action would be withdrawn).

Applicant also alleges that the examiner is precluded from making a restriction in the present case due to actions by a different examiner in the parent case 07/760970.

The examiner does not agree since each patent application (and its accompanying claims) are treated on their own merits. See particularly MPEP 811.04 which states:

"Even though inventions are grouped together in a requirement in a parent application, restriction or election among the inventions may be required in the divisional applications, if proper."

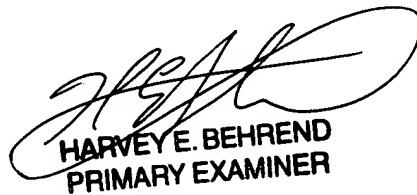
Note that for applicants response to be complete, it must include an election of the species set forth in each of sections 2 and 5 of the 6/6/01 Office action. See 37 CFR 1.111. Since the

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above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication should be directed to Mr. Behrend at telephone number (703) 305-1831.

Behrend/cw
September 14, 2001



HARVEY E. BEHREND
PRIMARY EXAMINER